

When the applicant's invention is used for pitching baseballs the transmitter is located in a home plate as shown in Figure 1. An alternative embodiment of the invention, such as when used for propelling ping pong balls, does not have a home plate so the transmitter 14 must be located elsewhere, such as transmitter 45 worn on a belt at the waist of a player, or as transmitter 46 worn on the wrist of a player. To make it clear that the transmitter containers 45 and 46 are two alternative embodiments of the invention, the applicant has amended the paragraph starting on page 10, line 28 to read in part:

"Alternatively, either a small transmitter 45 that may be worn either on a belt of the player as shown, or a small transmitter 46 that may be worn on the wrist of the player, is utilized, both as shown in Figure 5. The transmitters 45 or 46 are packaged in a [is] relatively small container [45-with] having seven buttons thereon (corresponding to switches 15a-g on home plate 14) that is mounted on the players belt, or on a player wrist with a strap, both as shown in Figure 5."

Next the Examiner objects to the drawings: "because Figure 1 shows 3 individual pieces of the invention. Label 10: cannot be used to label all 3 views. It is suggested that they be separated into Figure 1A, Figure 1B and Figure 1C." The applicant respectfully disagrees with the Examiner because the element number 10 is referring to the hitting practice equipment system as a whole which is made up of the individual elements designated by the other element numbers. However, to remove this objection the applicant has amended Figure 1 to remove element number 10 there from, and from the only two paragraphs in the specification that mention element number 10. They are the paragraphs starting at page 3, line 18, and the paragraph starting at page 5, line 8.

The Examiner then notes that an Abstract should be no more than 150 words in length. The applicant's Abstract was a little longer than this so the Abstract has been amended to shorten it to the required length.

The Examiner then objects to two informalities in the specification that the applicant hereby corrects. On page 3 line 21 "15a-15f" should be "15a-15g"; and on page 1 line 24 the word "peace" should be "piece". The applicant has amended the specification at these two places to make the appropriate corrections.

Next the Examiner objects to claims 3, 7, 9, 14, 16, 18 and 19 for the following informalities:

1. Claims 3 and 7 state "the signals" however, in the claims on which they depend, "signal" is singular and not pluralized, therefore in claims 3 and 7, need to be rewritten to read, "wherein the signal is..."
2. Claim 9 states "toward individual". The word "the" or "said" needs to be inserted before "individual".
3. Claims 14, 16 and 19 state "individuals voice" it should read "individual's voice".
4. Claim 18 states "with claim 9 2 further..." The number "9" needs to be deleted. Based on a conversation with the attorney claim 2 was used in this claim for examination purposes.

The applicant has amended claims 3, 7, 9, 14, and 16, and claim 18 has been deleted, as part of correcting these informalities.

Next the Examiner objects to claims 18, 25, 26 and 30 as being duplicates of other claims. The applicant has deleted claims 18, 19, 25, 26 and 30 to overcome this objection and has amended claim 27 to make it depend from claim 24. Accordingly, this objection is believed to be overcome.

The Examiner then rejects claims 1-3, 13, 15, 18, 20 and 21 under both 35 U.S.C. 102(e) as anticipated by Brown, U.S. Patent No. 6,440,013, and under 35 U.S.C. 103(a) as obvious in

view of the same Brown patent. The Examiner then points to a number of facets of the Brown invention in the '013 patent to support his position. While the things that the Examiner points out in the Brown '013 patent are true, the Brown patent does not suggest or teach the use of a plate on the ground in which the transmitter is located, and the transmitter is activated by touching it with a ball striking means to transmit a wireless signal that causes the ball to be propelled by a propelling means. Brown does teach a remote control device 200 that uses an infrared transmitter 222 to communicate with the pitching machine to indicate pitches to be projected but that device is a discrete box as shown in Figures 4A and 4B that is operated by hand to program pitches using a keypad. These differences are contained in applicant's dependent claims 4, 12, 23 and 24 which have been merged into the two independent claims 1 and 20. Amended claims 1 and 20 are as follows and are now believed to be allowable in this regard.

1. Hitting practice training equipment for use by an individual, said equipment comprising:

a ball to be hit by the individual as part of said hitting practice;

means for propelling the ball;

means for striking a ball propelled by said propelling means to impose a force by the striking means against the ball;

a plate on the ground toward which the ball is propelled by the propelling means; and

a transmitter located in the plate and touched by the individual using the striking means to transmit a signal that causes the ball to be propelled by the propelling means in a manner specified by the individual.

20. A method for an individual to have hitting practice using means for propelling baseballs toward a home plate and hitting the baseballs with a bat, the method comprising the steps of:

transmitting a wireless signal from a transmitter that is in the home plate to cause the actuation of the propelling means to propel a baseball toward the home plate in a manner specified by the individual; and

receiving the transmitted signal and causing the propelling means to propel a baseball in the manner specified by the individual, that the individual will attempt to strike using the bat.

Continuing, the Examiner rejects claim 4 under 35 U.S.C. 103(a) "as being unpatentable over Brown in view of Lipps, U.S. Patent No. 5,741,182." To combine the Lipps patent with the Brown patent The Examiner states that: "Brown lacks in disclosing that a home plate contains the transmitter [claims 4, 12, 24]. Lipps teaches of a baseball game, which uses a bat and a home plate. The home plate contains a transmitter and the transmitter is actuated to send the transmitted signal by touching the home plate (See Lipps Fig. 2; col. 3 lines 46-52, 63-67) [claims 4, 12, 24]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a home plate containing the transmitter in the invention of Brown."

The applicant respectfully disagrees with the Examiner for the following reason. The Lipps patent does teach a home plate that "contains a transmitter and the transmitter is actuated to send the transmitted signal by touching the home plate" but its purpose is entirely different than for the applicant's invention. The purpose for the home plate in the Lipp's patent is as follows:

At col. 3, l. 31 - 38 in the Lipp's patent we read:

"In other typical embodiments of the invention for baseball, as illustrated in FIG. 2, an infrared motion sensor is mounted in a stationary component such as a simulated home plate, and the player swings an ordinary type of baseball bat. The presence of the bat in the hitting area is sensed by a reflection or interruption of

the infrared signal emitted from home plate. The signal is conveyed by a hard-wired connection to the video game.” (See also Figure 3)

At col. 3, l. 42 - 46 we read:

“Referring now to FIG. 2, a device 40 that represents home plate is connected to the video game system or computer 41 by a cable 42, typically to the port 43 that is normally used for a hand-held controller with buttons or a joystick.”

At col. 3, l. 46 - 54 we read:

“The home plate 40 typically includes an infrared transmitter 44 and detector 45 pair as in FIG. 3 or other sensing means such as ultrasonics or visible light components that can determine the exact timing of the player's swing. The player swings a bat 46 (wood, aluminum, plastic, foam, etc.) over the home plate 40 in response to the pitch. The home plate 40 sends a signal that emulates a button press on the hand-held control.”

As for other uses of the home plate, at col. 3, l. 63 - 67 we read:

“Control buttons 47 are provided on the home plate 40 or in another convenient area to control other aspects of the offense, such as lead-offs and stolen bases. The controls 47 are sized and located in a manner to allow the player to operate the buttons either with the bat or by hand.

There is no suggestion or teaching anywhere in the Lipp's patent that the buttons on the home plate are used by the batter to select types of pitches to be tossed to the batter, or that the batter knows what pitches are being tossed “on the TV or computer screen”. It is clear that the

player is not to know what type of pitches are to be thrown because in real play they don't know, and in a real simulation they won't know either. That is the case with the Lipp patent.

At col. 1, lines 38 - 44 we read:

"The present invention adds to the realism of such games by replacing the pushbuttons of the usual hand-held controller with an interactive device that allows the player to stand up and take a swing substantially as in an actual baseball game, or actively participate in other sports in a similar manner."  
(underlining emphasis added)

At col. 3, l. 51 - 53 it states that:

"The home plate 40 sends a signal that emulates a button press on the hand-held control."

This is the only reference in the Lipp's patent to a "hand-held control", and since the bat is the only thing that it is hand-held and has controls on it, as we see in Figure 1, it must be the hand-held control referred to.

At col. 2, l. 46 - 48 we read:

"The simulated bat typically contains also a button pad 6 just above the grip of the bat to allow the player to select options and control of the game."

and at col. 2, l. 65 - 67 we read:

"a keypad on the simulated bat to allow the player to make selections pertaining to the setup and play of the game (e.g., selecting a lineup or controlling a base runner);"

In view of the above described realism that is stated by Lipps to be provided with the simulated game, the keypad will only be used by a player to select "setup and play of the game" but the batter does not use the keypad to select types of pitches to be thrown to them, or to indicate when a pitch is to be made. In addition, there is no suggestion or teaching in the Lipps et al patent that their invention can or will be used for batting practice. See a detailed discussion of obviousness further in these remarks.

The applicant's have amended their two independent claims 1 and 20 to carefully distinguish them from the Brown and Lipps patent and all other patents cited by the Examiner, and the home plate with transmitter of original claim 4 has been merged into amended claims 1 and 20.

Amended claims 1 and 20 read as follows and they clearly state that the purpose is for "hitting practice" and an individual using the training equipment uses the ball striking means to touch the plate "to transmit a signal that causes the ball to be propelled by the propelling means" toward the player "in a manner specified by the individual", not to setup and play a realistic game as taught by Lipp where a batter will not know what type of pitch will be thrown to them.

1. (Currently amended) Hitting practice training equipment for use by an individual, said equipment comprising:
  - a ball to be hit by the individual as part of said hitting practice;
  - means for propelling the ball;
  - means for striking a ball propelled by said propelling means to impose a force by the striking means against the ball;

a plate on the ground toward which the ball is propelled by the propelling means; and

a transmitter located in the plate and touched by the individual using the striking means to transmit a signal that causes the ball to be propelled by the propelling means in a manner specified by the individual.

20. (Currently amended) A method for an individual to have hitting practice using means for propelling baseballs toward a home plate and hitting the baseballs with a bat, the method comprising the steps of:

transmitting a wireless signal from a transmitter that is in the home plate to cause the actuation of the propelling means to propel a baseball toward the home plate in a manner specified by the individual; and

receiving the transmitted signal and causing the propelling means to propel a baseball in the manner specified by the individual, that the individual will attempt to strike using the bat.

Thus, the applicant contends that it would not be obvious to combine the teaching of the Lipps patent with the teaching of the Brown patent. Brown teaches a hitting practice machine, but the home plate with transmitter of the Lipps patent are for use in playing a realistic game where the batter does not control and does not know what pitches are going to be pitched to him in the game.

For the applicant's invention, as now claimed in amended claims 1 and 20, to be obvious in view of the patent combination of Brown and Lipps patents cited by the Examiner the need for the combination and operation must be at least suggested in the below cited case law. The applicant respectfully contends that the present invention, as now clearly claimed in amended claims 1 and 20, is not suggested in any of the cited prior art for the reasons described above.



In the key case *In re Fine*, 837 F.2d 1074, 5 USPQ2d 1596, (Fed. Cir. 1988), the court stated:

“But whether a particular combination might be ‘obvious to try’ is not a legitimate test of patentability. Obviousness is tested by ‘what the combined teachings of the references would have suggested to those of ordinary skill in the art’, but it ‘cannot be established by combining the teaching of the prior art to solve the problem of the claimed invention, absent some teaching or suggestion supporting the combination.’ Here the prior art contains none. And *‘teaching of references can be combined only if there is some suggestion or incentive to do so.’* Here the prior art contains none.”

“Instead, the Examiner relies on hind sight in teaching his obviousness rejection. “But, this court has said, to ‘imbue one of ordinary skill in the art with the knowledge of the individual, in suite, when no prior art reference or references as of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaching’. It is essential that ‘the decision maker forget what he or she has been taught about the claimed invention and casts the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then accepted wisdom in the art.”

“id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention.”

Again in *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 37 USPQ2d 1237 (Fed.Cir. 1995) the court stated:

"For a combination of prior art references to render an invention obvious, "there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). That one must point to some reason, suggestion, or motivation to make a combination is not to say that the teaching must be explicit, but in order to render an invention obvious by the combination of prior art references, the record must contain some basis to rebut the presumption of validity. See, e.g., Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1568, 224 USPQ 195, 198 (Fed. Cir. 1984). A finding of obviousness on any other basis would constitute hindsight. See Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.").

"A simple invention may be patentable, even if the invention comprises the combination of features known in the art, provided the combination itself is not obvious. See In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) ("A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.").

Then the Examiner states that claims 10, 11, 22 and 23, regarding a time delay in pitching and wireless transmission, are rejected: "under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Sharp, U.S. Patent No. 5,133,330." The Examiner then states that:

"Brown teaches that the signals are transmitted on a wireless basis to the receiver (See Brown col. 8 lines 47-63) [claim 11]. Brown further discloses that the game

piece is a ball (See Brown col. 3 line 67) and as previously stated it is either implicit that the striking means is a bat or it is certainly obvious for the reasons stated above (See Brown col. 2 line 67; col. 3 lines 1-8) [claim 23]. Brown lacks in disclosing a delay in the actuation of the propelling means [claims 10, 22]. Sharp teaches of a pitching machine in which when the machine receives the signal to cause the actuation of the propelling means to propel a game piece a delay occurs for a short period of time (See Sharp abstract, col. 1 lines 52-54; col. 2 lines 30-34) [claims 10, 22]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a delay after the receiver receives the transmitted signal in Brown so that the actuation of the propelling means is delayed. By delaying the throwing of the balls, the players can get into their batting stance and be ready for the pitch versus being surprised immediately by balls being thrown at them."

The applicant respectfully disagrees with the Examiner. As described in detail above, Brown does not suggest or teach the use of a plate on the ground in which the transmitter is located, and the transmitter is activated by a batter touching it with a ball striking means to transmit a wireless signal that causes the ball to be propelled by a propelling means in a manner specified by the batter. Brown does teach a remote control device 200 that uses an infrared transmitter 222 to communicate with the pitching machine to indicate types of pitches to be projected toward the batter but that device is a discrete box as shown in Figures 4A and 4B that is operated by hand to program pitches using a keypad.

The Sharp patent teaches a pitching machine in which when the pitching machine receives a signal from the batter to cause the actuation of the propelling means to propel a game piece after a short delay occurs before the ball is pitched.

Since the batter in Brown has to operate buttons on the remote control device 200 to specify a pitch, they need some minimal time to get ready to bat and hit at least the first

programmed pitch. Thus, combining the time delay of Sharp with the batting practice machine of Brown is at least suggested in those patents.

However, the applicant has amended claims 1 and 20 to clearly distinguish them from the Brown patent, as described above, and they are now believed to be allowable. Applicant's dependent claims 10, 11, 22 and 23 regarding time delay in pitching are believed to be allowable based on their dependency from allowed claims 1 or 20.

Next the Examiner rejects claims 14, 16, 17, 19, 29 and 30, regarding voice activation, under 35 U.S.C. 103(a) "being unpatentable over Brown in view of Trajkovic et al., U.S. Patent No. 6,539,931." Continuing the Examiner states:

"Brown lacks in disclosing a voice activated means [claims 14, 16, 17, 19, 28-30]. Trajkovic teaches of a ball throwing assistant comprising voice activated means that responds to the individual's voice for causing the propelling means to respond and propel a game piece in a different manner for each one of the plurality of voice actuated signals (See Trajkovic col. 5 lines 515, 25-33) [claims 14, 16, 17, 19, 29, 30]. It would have been obvious at the time the invention was made to use voice actuated signals in the invention of Brown so that the transmitter could transmit a signal to the receiver and the propelling means in response to a voice signal by the user. By using voice signals, the player's hands are free to hold the bat and maintain the batting stance. Consequently, the player can concentrate on batting and his physical position rather than pressing the correct buttons on a remote control."

The applicant respectfully disagrees with the Examiner. As described in detail above, Brown does not suggest or teach the use of a plate on the ground in which the transmitter is located, and the transmitter is activated by a batter touching it with a ball striking means to transmit a wireless signal that causes the ball to be propelled by a propelling means in a manner

specified by the batter. Brown does teach a remote control device 200 that uses an infrared transmitter 222 to communicate with the pitching machine to indicate types of pitches to be projected toward the batter but that device is a discrete box as shown in Figures 4A and 4B that is operated by hand to program pitches using a keypad.

However, the applicant has amended claims 1 and 20 to clearly distinguish them from the Brown patent, as described above, and they are now believed to be allowable. Applicant's dependent claims 14, 16, 17, 19, 29 and 30, regarding voice activation of pitching, are believed to be allowable based on their dependency from an allowed claim.

Next the Examiner rejects claims 5, 12 and 24 - 27 under 35 U.S.C. 103(a) "as being unpatentable over Brown in view of Lipps, in further view of Sharp, U.S. Patent No. 5,133,330." The Examiner then states that:

"Brown and Lipps lack in specifically disclosing a delay in the actuation of the propelling means [claim 5]. Sharp teaches of a pitching machine in which when the machine receives the signal to cause the actuation of the propelling means to propel a game piece a delay occurs for a short period of time (See Sharp abstract, col. 1 lines 52-54; col. 2 lines 30-34) [claims 5, 25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a delay after the receiver receives the transmitted signal in Brown so that the actuation of the propelling means is delayed. By delaying the throwing of the balls, the players can get into their batting stance and be ready for the pitch versus being surprised immediately by balls being thrown at them."

As the applicant has previously pointed out in detail he does not believe that that it is obvious to combine the teaching of the Brown and Lipps patents because Brown teaches a hitting practice machine, and the home plate with transmitter of the Lipps patent are for use in playing a realistic game where the batter does not control and does not know what pitches are going to be

pitched to him in the game. There is nothing in either the Brown or Lipps patents, or in other cited prior art, suggesting or teaching using the home plate of Lipps for designating pitches to be thrown to a batter, whether in a real game or a virtual game. To further combine the Sharps patent merely introduces the pitching machine receiving a signal from the batter to cause a time delay before the ball propelling means propels a ball.

Also as previously pointed out in detail, the applicant has amended claims 1 and 20 to clearly distinguish them from the Brown patent, as described above, and they are now believed to be allowable. The applicant's dependent claims claiming a time delay before pitching are believed to be allowable based on their dependency from allowable independent claims 1 or 20.

Then, the Examiner rejects voice activation claim 28 "under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Lipps, in view of Sharp, in further view of Trajkovic et al., U.S. Patent No. 6,539,931." Continuing, the Examiner states that:

"Brown, Lipps and Sharp lack in disclosing a voice activated means [claim 28]. Trajkovic teaches of a ball throwing assistant comprising voice activated means that responds to the individual's voice for causing the propelling means to respond and propel a game piece in a different manner for each one of the plurality of voice actuated signals (See Trajkovic col. 5 lines 5-15, 25-33) [claim 28]. It would have been obvious at the time the invention was made to use voice actuated signals in the invention. of Brown so that the transmitter could transmit a signal to the receiver and the propelling means in response to a voice signal by the user. By using voice signals, the player's hands are free to hold the bat and maintain the batting stance. Consequently, the player can concentrate on batting and his physical position rather than pressing the correct buttons on a remote control."

The applicant respectfully disagrees with the Examiner. As the applicant has previously pointed out in detail he does not believe that that it is obvious to combine the teaching of the

Brown and Lipps patents because Brown teaches a hitting practice machine, but the home plate with transmitter of the Lipps patent are for use in playing a "realistic" game where the batter does not control and does not know what pitches are going to be pitched to him in the game. There is nothing in either Brown or Lipps, or in other cited prior art, suggesting or teaching using the home plate of Lipps for designating pitches to be thrown to a batter, whether in a real game or a virtual game. See the above analysis of case law regarding obviousness. To further combine the Sharps patent merely introduces the pitching machine receiving a signal from the batter to cause a time delay before the ball propelling means propels a ball. To further combine the Trajkovic et al. patent merely introduces voice activation of the pitching machine.

Also as previously pointed out in detail, the applicant has amended claims 1 and 20 to clearly distinguish them from the Brown patent, as described above, and they are now believed to be allowable. The applicant's dependent claims claiming a time delay before pitching (Sharp) and the dependent claims claiming voice activation (Trajkovic et al), are believed to be allowable based on their dependency from an allowable independent claim 1 or 20.

Continuing with the rejections the Examiner rejects claims 6 and 7 under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Weske et al., U.S. Patent No. 6,575,837. Claim 6 covers the transmitter being located on the person apart from the striking means. The Examiner then adds that:

"Brown discloses that the transmitter is located apart from the striking means and the hands of the individual and that the individual actuates the transmitter to transmit the signal that causes the game piece to be propelled by the propelling means (claim 6). Furthermore, the signals are transmitted on a wireless basis to the receiver (See Brown col. 8 lines 47-63) claim 7). Brown lacks in disclosing the transmitter located on the individual [claim 6]. Weske et al. teaches of a fencing game in which a transmitter is located on the individual (See Weske et al. col. 3 lines 34-38) [claim 6]. It would have been obvious to one of ordinary skill

in the art at the time the invention was made to have the batter in Brown wear the transmitter as in Weske. By wearing the transmitter, the batter does not have to constantly pick up and put down the remote control device. The transmitter is on them at all times and the pitches can be selected faster versus picking up and using the remote control."

In the Weske et al patent at col. 3, l. 34 - 42 we read:

"In the preferred embodiment of the invention, the handle 18 of the apparatus 12 houses optical electronics 32 (FIG. 2) in the form of a chip. Each player also wears an attachable box 35, preferably at a belt location, which houses a wireless transmitter 34 and a power source 37, preferably a rechargeable nickel cadmium battery, for providing power to the transmitter 34 and the optical electronics 32. The wireless transmitter 34 is preferably a frequency modulated (FM) transmitter. In the preferred embodiment, a direct cable link 38 is used to connect the transmitter 34 to the optical electronics 32, providing power thereby." (underlining emphasis added)

When a fencing sword touches predetermined colored areas of an opponent there is an output from optics and electronics in the handle of the sword over a "direct cable link 38" to transmitter 34 in box 36 positioned on the waist belt of the fencer. When there is an output from the sword to box 35, indicating a touch of the sword on the opponent, transmitter 34 transmits a signal indicating the touch to "a remote location" where there is a display indicating the touch on a display 16. See col. 4, l. 17 - 25 where we read:

"The photodetector 44 produces an analog electrical signal when impinged upon by the light passed by the optical filter 42. As shown in FIG. 2, driver electronics 46 amplify the electrical signal produced by the photodetector 44 before transmission by the direct cable link 38 to the box 35. Once the amplified signal



reaches the box 35, the transmitter 34 transmits the signal to a remote location, where the receiver 36 receives the signal and outputs the received signal to the display 16.”

Thus, there is no control of anything by the person wearing the box 35 on their waist in the Weske patent. If one were to combine this teaching of the Weske patent with the teaching of the Brown patent, there would be no control of the ball pitching machine of the Brown patent by a transmitter mounted on the belt of the individual using the pitching machine. The most that would be obvious under 35 USC 103(a) would be to connect a bat or paddle via a cable to transmitter 45 mounted on the waist of the batter and transmit a signal to a remote location when the person hits a pitched baseball.

In addition, the combination and operation of two teachings must be at least suggested in the prior art to combine them and there is no such suggestion in either the Brown or Weske patents to use one with the other.

Quoting a small portion of the above case law analysis of obviousness, in the *In re Fine* case, 837 F.2d 1074, 5 USPQ2d 1596, (Fed. Cir. 1988), the court stated:

“But whether a particular combination might be ‘obvious to try’ is not a legitimate test of patentability. Obviousness is tested by ‘what the combined teachings of the references would have suggested to those of ordinary skill in the art’, but it ‘cannot be established by combining the teaching of the prior art to solve the problem of the claimed invention, absent some teaching or suggestion supporting the combination.’ Here the prior art contains none. And *‘teaching of references can be combined only if there is some suggestion or incentive to do so.’* Here the prior art contains none.”

Applicant's amended claims 1 and 20 are focused on a transmitter mounted in a home plate and controlled by a batter to specify pitches to be thrown by the pitching machine. Therefore, the applicant has added a new claim 31 that focuses on the transmitter being "located on the individual and touched by them to transmit a signal that causes the ball to be propelled towards them by the propelling means in a manner specified by the individual using the transmitter." Original claims addressing the transmitter being located on the individual have been deleted. New claim 31 is as follows:

31. (New) Hitting practice training equipment for use by an individual, said equipment comprising:

a ball to be hit by the individual as part of said hitting practice;

means for propelling the ball;

means for striking a ball propelled by said propelling means to impose a force by the striking means against the ball;

a transmitter located on the individual and touched by them to transmit a signal that causes the ball to be propelled towards them by the propelling means in a manner specified by the individual using the transmitter.

Next the Examiner rejects claims 8 and 9, regarding time delay of a pitch, under 35 U.S.C. 103(a) "as being unpatentable over Brown in view of Weske in further view of Sharp, U.S. Patent No. 5,133,330." Continuing, the Examiner states that:

"Brown further discloses that the propelling means is intended to propel the game piece toward the individual with the striking means (See Brown col. 2 lines 63-67; col. 3 lines 1-8) [claim 9]. Brown and Weske lack in disclosing a delay in the actuation of the propelling means [claim 8]. Sharp teaches of a pitching machine in which when the machine receives the signal to cause the actuation of the propelling means to propel a game piece a delay occurs for a short period of time (See Sharp abstract, col. 1 lines 52-54; col. 2 lines 30-34) [claim 8]. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have a delay after the receiver receives the transmitted signal in Brown so that the actuation of the propelling means is delayed. By delaying the throwing of the balls, the players can get into their batting stance and be ready for the pitch versus being surprised immediately by balls being thrown at them."

The applicant respectfully disagrees with the Examiner. As described in detail above there is no control of anything by the person wearing the box 35 on their waist in the Weske patent. Combining the Weske patent with the Brown patent would only yield a pitching machine where a bat is connected via a cable to transmitter 45 mounted on the waist of the batter and it transmits a signal to a remote location when the person hits a baseball. There is no control of pitches that are thrown. Combining the Sharp patent with Brown and Weske only introduces a time delay to a pitch that is not controlled by the transmitter on the batter's waist or wrist.

In addition, the combination and operation of two teachings must be at least suggested in the prior art to combine them and there is no such suggestion in either the Brown or Weske patents to use one with the other. See again the above detailed analysis of obviousness based on case law.

Finally the Examiner identifies other prior art that is made of record and not relied upon but is considered pertinent to applicant's disclosure. The applicant has carefully reviewed the three patents cited by the Examiner: (a) Ragoza et al., U.S. Patent No. 6,244,260; (b) Kovacs et al., U.S. Patent No. 5,125,653; and (c) Rappaport et al., U.S. Patent No. 6,190,271 but does not believe that they suggest or teach the applicant's invention either singly or in any combination.

In view of the above arguments this patent application is now believed to be in condition for allowance and passage to issuance is respectfully requested. If there remain any matters that may be resolved by telephone the Examiner is invited and authorized to contact the undersigned

attorney via telephone at (603) 432-8788, via fax at (603) 421-2779, or via e-mail at  
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Sincerely,

A handwritten signature in cursive script that reads "Joseph E. Funk".

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